

Remarks

1. The Examiner has rejected all the presently pending claims (1 to 6, 15 to 19 and 21 to 23 as being unpatentable under 35 U.S.C. 103(a) over Gerszberg et al (US6714534) in view of Watanabe (US5715250). The Examiner will be aware that in *ex parte* examination of patent applications, the Patent and Trademark Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent and Trademark Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent and Trademark Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grablak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable

expectation of success must both be found in the prior art, and not based on applicants' disclosure. MPEP § 2142.

2. Applicants do not comment in this response on the relevance of the disclosure of Gerszberg to the presently pending claims, but the absence of any such discussion should not be taken as the Applicants' agreement to the position adopted by the Examiner with respect to this newly cited reference.

3. It is only necessary on this occasion to consider the disclosure of Watanabe and what the Examiner contends is disclosed in this reference. Referring to claim 1, it is the Examiner's position that Gerszberg does not disclose "*segmenting said first and second IP packet streams into respective first and second ATM cell streams; and multiplexing said first and second ATM cell streams together for transport over said upstream communication path*", but that these limitations of claim 1 are found in Watanabe. Further, the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Gerszberg using the features taught by Watanabe in order to have an efficient communication system by providing a small scale ATM-LAN connection apparatus which enables communication between terminals of different standards. Applicants respectfully disagree with the Examiner's position on what is taught by Watanabe.

4. Watanabe teaches an ATM-LAN connection apparatus 1 which is located between a first ATM terminal 2 of a LAN emulation protocol and an ATM switch 3 which serves a plurality of second ATM terminals 4-1 to 4-3 of an IP over ATM protocol. The ATM-LAN connection apparatus enables the first ATM terminal 2 of a first standard to communicate via the ATM switch 3 with any of the plurality of second ATM terminals 4-1 to 4-3 of a second, different standard. When the first ATM terminal 2 is communicating with a selected one of the second ATM terminals 4-1 to 4-3, an ATM cell from the first terminal 2 is received at the ATM-LAN connection apparatus 1 where it is processed in a first protocol layer by firstly being

converted to a LAN emulation frame 30 by a first AAL 5 SAR section 12, then passed to a LAN emulation protocol processing section 13 which delivers the LAN emulation frame 30 to a bridging section 19. The bridging section 19 converts the LAN emulation frame 30 to an IP over ATM and passes this to an IP over ATM protocol section 17 which locates a destination address, e.g. ip4, for the IP datagram contained in the IP over ATM frame. The IP over ATM frame is delivered to a second AAL5 SAR section 16 which segments the frame into an ATM cell. The ATM cell is transmitted to the ATM switch 3 which uses the IP destination address (e.g. ip4) to deliver the IP datagram to the selected one of the second ATM terminals 4-1 to 4-3 (column 5, lines 18 to 46). The process for transmitting an ATM cell from one of the second ATM terminals to the first ATM terminal is described at column 5, line 52 to column 6, line 16.

5. Applicants have considered carefully the whole of the disclosure of Watanabe and have been unable to identify any disclosure (whether explicit or implicit) or any suggestion of *"first and second IP packet streams"* or of *"segmenting said first and second IP packet streams into respective first and second ATM cell streams"* or of *"multiplexing said first and second ATM cell streams together for transport over said upstream communication path"*. The reference in the Office Action to "Fig. 3, ip4, ip5" of Watanabe does not in itself disclose any of the foregoing claim limitations. In Watanabe, ip4 and ip5 are respective destination addresses for some of the second ATM terminals 4-1 to 4-3. It is not possible or reasonable to extrapolate this fleeting reference into the substantive claim limitations that distinguish the present invention over the prior art of record. Also, Watanabe is completely devoid of any reference to multiplexing, etc. Applicants therefore request that, if the Examiner remains of the view that such limitations of claim 1 of the present invention are taught by Watanabe, he indicate exactly where in Watanabe such features are disclosed. This is a necessary step to discharging the obligation incumbent on the USPTO, as established in law, when making rejections under 35 U.S.C. §103(a). In the absence of any such indications fully supporting the 35 U.S.C. §103(a) rejection of the

currently pending claims, the USPTO is obliged to allow this application since the combination of Gerszberg and Watanabe cannot be said to disclose all of the claim limitations.

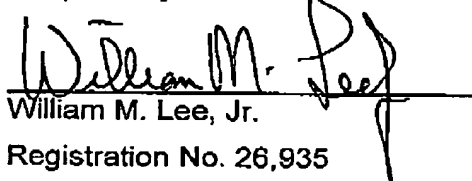
6. The submission of section 5 of this paper is equally applicable to Independent claims 15, 16 and 21.

7. Notwithstanding the foregoing, one of ordinary skill in the art would not seriously contemplate using the teaching of Watanabe to modify the system of Gerszberg since Watanabe is directed to providing an efficient communication system by providing a small scale ATM-LAN connection apparatus which enables communication between terminals of different standards. In contrast, Gerszberg is directed to enabling interexchange companies to gain access to a subscriber's twisted pair or coaxial cable therefore by passing the local telephone company. One skilled in the art would therefore not look to Watanabe to improve the system of Gerszberg.

8. Favorable reconsideration of the claims is therefore requested.

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Respectfully submitted,



William M. Lee, Jr.

Registration No. 26,935

Barnes & Thornburg LLP

P.O. Box 2786

Chicago, Illinois 60690-2786

(312) 214-4800

(312) 759-5646 (fax)

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